

REMARKS

As an initial matter, of claims 1-58 which were originally contained in the pending application, *claims 10-13 and 32 were canceled in the prior response*. Applicants request that the Examiner make this change of record as it is not reflected in the subsequent Office Action (rejections include cancelled claims). Note that claim 58 was canceled in the Preliminary Amendment.

Rejections Under 35 U.S.C. §103(a)

(¶2) The Examiner has rejected claims 1-30, 32-42, 46, 47 and 49-57 under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al (WO 01/47368). In making this rejection, the Examiner has repeated his rejection from the earlier office action, and further maintains that the non-biodegradable polymers incorporated into the chewing gum of Goldberg et al. are an “optional” component, based upon statements made on page 4, lines 5-7. The Applicants respectfully traverse this rejection as Goldberg et al. does not disclose a biodegradable chewing gum.

The Applicants contend that the Examiner’s arguments are based upon a misinterpretation of the wording on page 4, lines 5-7 in Goldberg et al. which states:

*Apart from the desirable copolymers of the present invention, the composition of the gum base is **not critical** to the present invention.*

The phrase “not critical” is apparently interpreted by the Examiner to mean “optional”, which, based on the additional wording on page 4, is a misinterpretation of this statement. Goldberg et al. lists suitable polymer for use in gum bases and these are provided on page 4, lines 12-23. These polymers may not be critical in the sense

that several combinations are possible with the degradable polymers disclosed. However, the listed polymers are not entirely “optional.” An interpretation along the lines the Examiner is using would mean that everything but the biodegradable polymer is optional and would ultimately lead to a chewing gum consisting of nothing but a degradable polymer which is a meaningless result. In fact, the Examiner’s interpretation opposes the teachings of Goldberg et al.

The only example in Goldberg et al. which uses a gum base (example 48) discloses a gum base having 20% of a biodegradable polymer and 63.25% non-biodegradable polymers. The skilled person in the art, reading Goldberg et al. and this example, is left without any guidance as to how to prepare a truly biodegradable gum base. If 63.25% of the gum base (76% of the gum base polymers) is considered to be “optional”, it would not be obvious to one skilled in the art as to how to replace these optional polymers in order to obtain biodegradability while also forming a gum base with an acceptable texture.

Further, it is also not obvious as to how one skilled in the art would arrive at the invention described in claim 1 of the pending application, which claims:

Chewing gum comprising at least one biodegradable polymer, wherein the molecular weight of said biodegradable polymer is at least 105000 g/mol (Mn), wherein the chewing gum is substantially free of non-biodegradable polymers.

It is not clear from example 48 of Goldberg et al. exactly which polymer is used in the gum base. The list of ingredients includes “copolymer of example 9”, while the descriptive portion of the example refers to “the copolymer of example 7”. It is also noted that neither of these copolymers has a number average molecular weight of “at least 105000 g/mol.” It is also noted that Goldberg et al. disclose that it is preferable to use polymers having a low molecular weight which is from about 10,000 to 90,000g/mol (p. 19, lines 19-20). This is in marked contrast to the high

molecular weight polymers which are included in the chewing gum of the pending application and it is these high molecular weight polymers which confer the desired elastic properties to the gum base and not the low molecular weight polymers disclosed in Goldberg et al.

The chewing gum disclosed in Goldberg et al. (see example 49) contains 5.2% biodegradable polymers and 16.4% conventional polymers. A person skilled in the art *would not* regard these 16.4% conventional polymers as “optional” chewing gum ingredients, despite the wording found on p. 4, lines 5-7 of Goldberg et al. Quite to the contrary, and in view of the disclosure of Goldberg et al. it is clear that conventional polymers are needed to obtain a chewing gum with acceptable texture and other desired characteristics. Accordingly, based upon the above arguments, the Examiner’s contention that preclusion or elimination of the conventional polymers from the gum base would have been “obvious” has been overcome and should be withdrawn.

Consequently, in view of the above arguments, the rejections under 35 U.S.C. §103(a) have been overcome and should be withdrawn.

Double Patenting Rejection

Claims 1-57 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims: 1-62 of co-pending application 10/472,122; claims 1-54 of co-pending application 10/472,154; claims 1-67 of co-pending application 10/528,926; claims 1-64 of co-pending application 10/529,133; claims 1-20, 22-26, and 28-42 of co-pending application 10/529,137; and claims 1, 2, 10, 11, 13-18, 24-26 and 28-54 of co-pending application 11/088,109.

Upon indication of allowable subject matter in this case, Applicants will file the appropriate terminal disclaimers in order to overcome these rejections.

The present application as amended herein, is now in form for allowance and early reconsideration and allowance of the claims, as currently pending, is earnestly solicited.

Respectfully submitted,

ANDERSEN, ET AL.

By Karlyn A. Schnapp
Karlyn A. Schnapp
Registration No. 45,558
Attorney for Applicants

FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202
(513) 651-6865

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being electronically filed with The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, this 18th day of December 2008.

Eileen Andrews